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Attorney's Docket No.: 18202-017001 / 1081



# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lin Zhi et al.

Art Unit: 1625

Serial No.: 10/080,926

Examiner: Evelyn Huang

Filed

: February 22, 2002

Cust. No. : 20985

Conf. No.:

7786

Title

TRICYCLIC ANDROGEN RECEPTOR MODULATOR COMPOUNDS AND

**METHODS** 

**Mail Stop Amendment** 

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

## TRANSMITTAL LETTER

Dear Sir:

Transmitted herewith are a Supplemental Information Disclosure Statement and Forms PTO-1449 (2 pages), and cited non U.S. Patent references for filing in connection with the above-identified application. Because this Supplemental Information Disclosure Statement is filed prior to receipt of a first Office Action on the merits of the Request for Continued Examination of the above-captioned application, no fee is due. However, should it be determined that a fee for filing these papers is required, the Commissioner is authorized to charge Deposit Account No. 06-1050, as stated below:

 $\boxtimes$ 

The Commissioner is hereby authorized to charge any fees that may be due in connection with this paper or with this application during its entire pendency to Deposit Account No. 06-1050. A duplicate of this sheet is enclosed.

Respectfully/sub/mitted

Stephanie Seidman Reg. No. 33,779

Attorney Docket No. 18202-017001/1081

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I hereby certify that this paper is being deposited with the United States Postal "Express Mail Post Office to Addressee" Service under 37 CFR §1.10 on the date indicated above and is addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

Stephanie L. Se

Attorney's Docket No.: 18202-017001 / 1081



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## SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT IN ACCORDANCE WITH 37 C.F.R. §§ 1.97-1.98

This Supplemental Information Disclosure Statement is filed prior to receipt of a first Office Action on the merits of the Request for Continued Examination of the abovecaptioned application. Thus, a fee for filing this statement should not be due. If, however, it is determined that a fee is due, any fees that may be due in connection with filing this paper may be charged to Deposit Account No. 06-1050.

In accordance with the duty of disclosure imposed by 37 C.F.R. §1.56 to inform the Patent Office of all references known by Applicant or Applicant's representative that may be material to the examination of the subject application, Applicant's representative hereby provides this Information Disclosure Statement that is prepared in accordance with 37 C.F.R. §§1.97-1.98. Forms PTO-1449 (2 pages) and copies of the cited non U.S. Patent documents are provided herewith.

With the exception of items AQ, AR, and BF, the documents cited on the Form PTO-1449 are in the English language. German Patent Application No. DE 2427409 (item AO), which is in the German language, is provided with an English language equivalent, US Patent No. 3,919,238 (item AB). Japanese Patent Application No. 50-25595 (item AR), which is in the Japanese language, is provided with an English language abstract (item AZ).

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Stephanie L. Seidman,

Attorney's Docket No.: 18202-017001 / 1081

Applicant: Lin Zhi et al. Serial No.: 10/080,926 : February 22, 2002

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Supplemental Information Disclosure Statement

The publication by Lancelot et al. (item BF), which is in the French language, is provided with an English language abstract on the first page of the article. Hence, in accordance with the requirements of 37 C.F.R. §1.98, as amended effective March 16, 1992, no further explanation of the listed items is necessary.

Applicant also makes known to the Examiner the following pending U.S. and International Applications that have one or more common inventors and/or are commonly owned:

| Docket No.   | U.S.S.N.   | <u>Filed</u> | Publ. No.    |
|--------------|------------|--------------|--------------|
| 007002/1033B | 09/277,405 | 03/26/99     | n/a          |
| 033001/1051  | 09/463,542 | 01/21/00     | n/a          |
| 015002/1073B | 10/299,209 | 11/18/02     | 20030130505  |
| 018001/1082  | 10/080,503 | 02/22/02     | 20020183314  |
| 051001/1814  | 10/211,969 | 08/01/02     | n/a          |
| 013002/1062B | 10/238,363 | 09/09/02     | 20030186970  |
| 005003/1028C | 10/360,580 | 02/05/03     | 20040019072  |
| 020001/1088  | 10/684,229 | 10/10/03     | 20040152718  |
| 057001/1091  | 10/684,227 | 10/10/03     | 20040147530  |
| 003014/1014N | 10/739,933 | 12/17/03     | 20040186132  |
| 002007/1002F | 08/141,246 | 10/22/93     | n/a          |
| 002009/1002H | 08/141,496 | 10/22/93     | n/a          |
| 004002/1026B | 08/484,487 | 06/07/95     | n/a          |
| 004003/1026C | 10/847,732 | 05/17/04     | 2004-0209839 |
| 035002/1059B | 10/229,649 | 08/27/02     | 2003-0013766 |
| 048001/1087  | 10/684,212 | 10/10/03     | 2004-0152717 |

| Docket No.    | Intl. No.       | <u>Filed</u> | <u>Publ. No.</u> |
|---------------|-----------------|--------------|------------------|
| 057WO1/1091PC | PCT/US03/24416  | 08/04/03     | WO2004/033459    |
| 020WO1/1088PC | PCT/US03/24419  | 08/04/03     | WO2004/033460    |
| 048WO1/1087PC | PCT/US03/24420  | 08/04/03     | WO2004/033461    |
| 022WO1/1096PC | PCT/US04/022907 | 07/16/04     | Awaiting         |
| 023WO1/1097PC | PCT/US04/023788 | 07/16/04     | WO 2005/009104   |
| 024WO1/1098PC | PCT/US04/023093 | 07/16/04     | Awaiting         |
| 026WO1/1100PC | PCT/US04/023010 | 07/16/04     | WO 2005/010202   |
| 030WO1/1111PC | PCT/US04/027483 | 08/23/04     | Awaiting         |

Although these documents are made known to the Patent and Trademark Office in compliance with Applicant's duty of disclosure, such disclosure is not to be construed as an admission by Applicant or Applicant's representative that any of the references, singly or in any combination thereof, is effective as prior art against the subject application. In accordance with 37 C.F.R. §1.97(h), the filing of this Information Disclosure Statement shall Applicant : Lin Zhi et al. Attorney's Docket No.: 18202-017001 / 1081 Serial No. : 10/080,926

Filed : February 22, 2002

Page : 3 of 3

Supplemental Information Disclosure Statement

notible construed to mean that a search has been made or that no other material information as defined in 37 C.F.R. §1.56(b) exists.

Applicant respectfully requests that the Examiner review the foregoing references and they be made of record in the file history of the above-captioned application.

Respectfully submitted,

Stephanie Seldman Reg. No. 33,779

Attorney Docket No. 18202-017001 / 1081

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|                     |              | partment of Commerce<br>and Trademark Office |                     | Attorney's Docket No.<br>18202-017001/1081 |  | Application No. 10/080,926 |                            |  |
|---------------------|--------------|--|---------------------|--|--|----------------------------|----------------------------|--|
|                     |              | d Publications<br>n Disclosure St            |                     | Applicant Lin Zhi et al.                   |  |                            |                            |  |
| (37 CFR §1.98       | 3(b))        |  |                     | Filing Date<br>February 22, 2002           | Filing Date Group Art Unit<br>February 22, 2002 1625 |                            | :                          |  |
|                     | • "          |  | U.S. Pater          | nt Documents                               |  |                            |                            |  |
| Examiner<br>Initial | Desig.<br>ID | Document<br>Number                           | Publication<br>Date | Patentee                                   | Class  | Subclass                   | Filing Date If Appropriate |  |
| •                   | AA           | 2002/0183314                                 | 12/05/02            | Higuchi et al.                             | 514  | 224.5                      | 02/22/02                   |  |
|                     | AB           | 3,919,238                                    | 11/11/75            | Spencer et al.                             | 260  | 288                        | 06/06/73                   |  |
|                     | AC           | 4,460,475                                    | 07/17/84            | Hayatsu et al.                             | 210  | 674                        | 03/25/83                   |  |
|                     | AD           | 4,623,638                                    | 11/18/86            | Hayatsu et al.                             | 502  | 401                        | 03/21/85                   |  |
|                     | AE           | 4,777,052                                    | 10/11/88            | Weisburger et al.                          | 426  | 92                         | 01/06/87                   |  |
|                     | AF           | 4,981,784                                    | 0101/91             | Evans et al.                               | 435  | 6                          | 11/30/88                   |  |
|                     | AG           | 5,011,697                                    | 04/30/91            | Jones et al.                               | 426  | 92                         | 08/06/88                   |  |
|                     | AH           | 5,071,773                                    | 12/10/91            | Evans et al.                               | 436  | 501                        | 10/20/87                   |  |
|                     | AI           | 5,179,202                                    | 01/12/93            | Gross                                      | 536  | 120                        | 11/16/90                   |  |
|                     | AJ           | 6,017,924                                    | 01/25/00            | Edwards et al                              | 514  | 292                        | 08/12/99                   |  |
|                     | AK           | 6,030,967                                    | 02/29/00            | Marui et al.                               | 514  | 215                        | 10/30/97                   |  |
|                     | AL           | 6,180,794                                    | 01/30/01            | Edwards et al.                             | 546  | 152                        | 10/15/99                   |  |
|                     | AM           | 6,340,704                                    | 01/22/02            | Marui et al.                               | 514  | 463                        | 10/25/99                   |  |

| Foreign Patent Documents or Published Foreign Patent Applications |              |                    |                     |                             |       |          |              |         |
|---|--------------|--------------------|---------------------|-----------------------------|-------|----------|--------------|---------|
| Examiner<br>Initial   | Desig.<br>ID | Document<br>Number | Publication<br>Date | Country or<br>Patent Office | Class | Subclass | Trans<br>Yes | slation |
|   | AN           | 0 638 571          | 04/28/93            | EP, A1                      |       |          |              |         |
|   | AO           | 02/066475          | 08/29/02            | PCT                         |       |          |              |         |
|   | AP           | 02/068427          | 09/06/02            | PCT                         |       |          |              |         |
|   | AQ           | 24 27 409          | 01/09/75            | DE (DT), A1                 |       |          |              | X*      |
|   | AR           | 50-25595           | 03/18/75            | JP                          |       |          |              | X*      |

| Other Documents (include Author, Title, Date, and Place of Publication) |        |  |  |  |
|---|--------|--|--|--|
| Examiner  | Desig. |  |  |  |
| Initial   | ID     | Document   |  |  |
|   | AS     | Berger et al., "Interaction of glucocorticoid analogues with the human glucocorticoid receptor," J. Steroid Biochemistry and Molecular Biology 41(3-8): 733-738 (1992) |  |  |
|   | AT     | Bolognese et al., "Photochemistry of Ommochrome Pigments," J. Heterocyclic Chem. 25: 1243-1246 (1988)  |  |  |
|   | AU     | Bolognese et al., "Oxidation of 3-Hydroxykynurenine. A Reexamination,"," J. Heterocyclic Chem. 25: 1247-1250 (1988)  |  |  |

Examiner Signature

Date Considered

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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List of Patents and Publications for Applicant's

Information Disclosure Statement

Information Disclosure Statement

In This et al.

| lr                  | formatio     | n Disclosure Statem   | ent                      | Lin Zhi et al.  |  |
|---------------------|--------------|---|--------------------------|---|--|
|                     |              |   |                          | Filing Date   | Group Art Unit   |
| (37 CFR §1.98       |              |   |                          | February 22, 2002                                       | 1625   |
|                     | Other D      | ocuments (includ  | le Author,               | Title, Date, and Pla                                    | ce of Publication)   |
| Examiner<br>Initial | Desig.<br>ID |   |                          | Document  |  |
|                     | AV           | Bolognese et al., "Pho<br>Chem. 25: 979-983 (19   |                          | Ommochromes and Relate                                  | ed Compounds," J. Heterocyclic                                     |
|                     | AW           |   |                          | strate cancer," Aust. Prescr<br>magazines/vol19no1/ap19 | . 19:22-24 (1996)<br>-1-11.htm (accessed on 01/28/2005)            |
|                     | AX           | Castillo, P. and J.C. Rodriguez-Ubis, "A high-yield method for the methylenation of odihydroxyaromatic compounds: synthesis of methylenedioxycoumarins," Synthesis pp. 839-840 (1986)   |                          |   |  |
|                     | AY           | Chemical Abstracts vol. 54, no.8821, (1960) Mustafa et al., "Photochemical reaction in sunlight. Experiments with benzo[k]quinoline-5,6-quinone, monoamine and monoxmine derivatives in sunlight and in dark," J. A. Chem. Soc. 81:3409-3413 (1959) |                          |   |  |
| -                   | AZ           | Chemical Abstracts vo<br>"9-Halothiazoloquinol  |                          | 36, page 577 (1975) JP 50                               | -25595 published 03/18/75, entitled                                |
|                     | BA           | Claman et al., "SOGC clinical practice guidelines. Hirsutism: evaluation and treatment," J Obstet Gynaecol Can. 24(1):62-7 (2002)   |                          |   |  |
|                     | ВВ           | Debenedetti et al., "Iso<br>703 (1999)  | purasol, a cou           | marin from <i>Pterocaulon vi</i>                        | rgatum," Phytochemistry 51: 701-                                   |
|                     | ВС           |   |                          | hommatin-Derived Radical ochemistry and Biophysics      |  |
|                     | BD           |   | earrangement.            | Reiospecific Route to Sub                               | ks. Carbamoyl Rendition of the stituted 4-Hydroxycoumarins,"       |
|                     | BE           |   |                          | velic amines with mammar, iectomized rats," Cancer L    | y gland carcinogenic potential on etters 162: 31-37 (2001)         |
|                     | BF           |   |                          | [1,2-a]quinoxalines," Che stract on first page of artic | m. Pharm. Bull. 31: 3160-3167                                      |
|                     | BG           | LaMontagne et al., "A Chem. 25: 964-968 (1  | ntimalarials. 1:<br>982) | 3. 5-Alkoxy Analogues of                                | 4-Methylprimaquine," J. Med.                                       |
|                     | вн           | Receptor," The Journa   | l of Biological          | Chemistry 266(1): 510-51                                |  |
|                     | BI           | Singh et al. "Androgen recentor antagonists (antiendrogens); structure activity relationships?  |                          |   | ructure-activity relationships," Curr.                             |
|                     | ВЈ           | Willard et al., "Potent   | ial Diuretic-β-          | Adrenergic Blocking Agen<br>yl]-1,4-dioxino[2,3-g]quino | ts: Synthesis of 3-[2-[1,1-<br>olines," J.Org. Chem. 46: 3846-3852 |

| Examiner Signature  | Date Considered |  |  |  |  |
|---|-----------------|--|--|--|--|
|   |                 |  |  |  |  |
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| conformance and not considered. Include copy of this form with next communication to applicant.   |                 |  |  |  |  |

(1981)